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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,085	03/11/2004	Barry N. Gellman	10124/01201	5328
36636 7590 12/22/2008 FAY KAPLUN & MARCIN, LLP 150 BROADWAY, SUITE 702 NEW YORK, NY 10038				
EXAMINER NGUYEN, VI X				
ART UNIT		PAPER NUMBER		
3734				
MAIL DATE		DELIVERY MODE		
12/22/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/798,085

Applicant(s)

GELLMAN ET AL.

Examiner

Victor X. Nguyen

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8,9 and 11-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16 is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8,9,11-15,17,18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The request filed on 10/27/2008 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/798,085 is acceptable and a RCE has been established. An action on the RCE follows.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3-6,9, and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Milliman et al (6,213,957).

Milliman discloses a biopsy system having the limitations as recited in the above listed claim, including: a first element guide is shown in fig. 44 is considered as a placeholder element 603 which has a first lumen extending therethrough to a distal opening, where a handle (half housing section of 518a,518b is considered as a handle) which is able to disconnect from the placeholder element 603 so that the first place holder element 603 may be left in the first selected location, where a tissue sampling element occurs at the tip of element 603 is capable of obtaining a sample of tissue from the first selected location, and capable of being remove from the first lumen and where the handle also includes a sampling element actuator 545 for operating the tissue sampling element 585, where the handle further comprises a safety lock 541.

At best seen in figures 42 and 44 the device of Milliman is capable of accessing multiple

sites in the tissue, and where the system comprises identification markings 601 and a biopsy needle (fig. 44).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8,11,12,15 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milliman (6,213,957) in view of Burbank (6,497,706).

Milliman discloses the invention substantially as recited in the claims. Milliman is silent regarding the tissue treatment element comprises one monopolar electrode.

Burbank discloses the tissue treatment element comprises one monopolar electrode 13 (see fig. 4). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Milliman by making the device has the tissue treatment element comprises one monopolar electrode as taught by Burbank to lead the probe to passthrough the tissue with very little tissue damage, because one of ordinary skill in the art would have been able to carry out such a substitution, and the results were reasonably predictable. As to claims 8 and 11-12, Burbank teaches, a first luer 23, a second luer 23'and the needle includes a suction lumen for applying suction to a sample of tissue (see col.6, lines 11-21).

Allowable Subject Matter

4. Claim 16 is allowable over the art of record.

Response to Arguments

5. Applicant's arguments filed 7/29/2008 have been fully considered but they are not persuasive. Applicant states that Milliman does not have a handle being removed coupled to the first place holder element. Examiner disagrees. The examiner notes that the limitation "a handle being removed coupled to the first place holder element" (a functional limitation): thus, a reference needs not show the structure of the recitation in order to meet the claim language but rather the reference needs only be capable of being use with such structure. (See MPEP 2111.04 an MPEP 2112.01). In fact, Milliman does have a handle (halt sections 518a,518b) being removed coupled to the first place holder element 603. Furthermore, the applicant argues that Milliman does not teach a tissue sampling element and a tissue treatment element. The examiner disagrees. It is noted that the tissue sampling element occurs at the anterior surface of segment 603 in figure 43 of Milliman. This anterior surface of segment 603 is very similar to applicant element 106 in figure 3 and the area of segment 585 is considered as the tissue treatment element. Accordingly, the above noted reference is still considered to read on the claimed limitations of the claims noted.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ho Jackie can be reached on (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin T. Truong/
Primary Examiner, Art Unit 3734

/Victor X Nguyen/
Examiner
Art Unit 3734

VN